IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
Luciano SILVA	:	Confirmation Number: 7485
	:	
Application No.: 10/759,409	:	Group Art Unit: 2454
	:	
Filed: January 16, 2004	:	Examiner: J. Park
	:	
For: PROGRAMMATIC ROLE-BASED SECURITY FOR A DYNAMICALLY		
GENERATED USER INTERFACE		

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated November 5, 2008.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of July

21, 2008, raises additional issues and underscores the factual and legal shortcomings in the

Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal

Brief of July 21, 2008, and the arguments set forth below.

1   **<u>REMARKS</u>**

2

3   Appellant has compared the statement of the rejection found on pages 3-10 of the

4   Examiner's Answer with the statement of the rejection found on pages 2-9 of the Second Office

5   Action. Upon making this comparison, Appellant has been unable to discover any substantial

6   differences between the respective statements of the rejection. As such, Appellant proceeds on

7   the basis that the Examiner's sole response to Appellant's Appeal Brief is found on pages 10-15

8   of the Examiner's Answer.

9

10   On page 5 of the Appeal Brief, Appellant pointed out where the Examiner's Answer is

11   required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has

12   completely ignored this requirement. As noted throughout the prosecution of this application

13   and in the Appeal Brief, the Examiner has failed to properly establish the facts underlying the

14   Examiner's analysis. Appellant's position is that these omissions in the Examiner's prima facie

15   analysis are correctable by the Examiner, and the correction of these omissions would help both

16   Appellant and the Honorable Board gain a better understanding of the alleged findings of facts

17   and analysis employed by the Examiner in rejecting the claims. Thus, Appellant respectfully

18   recommends that the Honorable Board remand the present application to the Examiner to address

19   these omissions.[1]

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[1] The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. E.g., Ex parte Daleiden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schricker, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection … We are not good at guessing; hence, we decline to guess."); Ex parte Braeken, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

1

2   <u>Rejection of claim 4 under 35 U.S.C. § 103</u>

3   The Examiner's initial set of arguments found on pages 11 of the Examiner's Answer is

4 reproduced below:

> 5   Examiner's response: Bazinet teaches of not providing (<u>equivalent</u> to applicant's omitting
> 6   a linkage) access (<u>equivalent</u> to applicant's linkage) when the processing of checking
> 7   authentication (<u>equivalent</u> to applicant's access checking logic) is indicated on the page (502 in
> 8   figure 5, <u>equivalent</u> to applicant's first view, see, e.g., page 4, paragraph [0039]-[0040]) to the
> 9   client's web browser. Therefore the processing of checking authentication (<u>equivalent</u> to
> 10   applicant's access checking logic) is programmed to omit the linkage not allowed based on the
> 11   authentication process.
> 12   Bazinet teaches that the portal application generates a page (<u>equivalent</u> to applicant's first
> 13   view) to the client containing links (<u>equivalent</u> to applicant's linkage) corresponding to the
> 14   backend applications that the authenticated user can access, based on the access privileges of the
> 15   authenticated user (see, e.g., page 3, paragraph [0038] and step 416 in figure 4).
> 16   Therefore Bazinet clearly teaches of omitting backend application links for the
> 17   unauthenticated user. (emphasis added)

18

19   At the outset, Appellant notes that the Examiner appears to be relying upon the

20 "equivalent" disclosure of many of the claimed limitations. However, the Examiner has not set

21 forth the necessary analysis to establish equivalency. In order to rely on equivalence as a

22 rationale supporting an obviousness rejection, the equivalency must be recognized in the prior

23 art, and cannot be based on applicant's disclosure or the mere fact that the components at issue

24 are functional or mechanical equivalents. <u>In re Ruff</u>, 256 F.2d 590, 118 USPQ 340 (CCPA

25 1958). Furthermore, within <u>In re Scott</u>, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963), a decision

26 of the Board was reversed on the basis that components that are functionally equivalent are not

27 necessarily obvious in view of one another. The Examiner's analysis, however, merely states

28 there is "equivalence" without establishing that the equivalency is recognized in the prior art or

29 obvious. Thus, the Examiner has committed legal error in rejecting the claims.

30

31 _____

1   On page 12 of the Examiner's Answer with regard to the claimed "access checking logic

2   disposed in said first view and programmed ...," the Examiner further asserted the following:

> 3   Examiner's response: Bazinet teaches of the access checking logic (processing of
> 4   checking authentication, 406-414 in figure 4) processed in the portal application (102 in figure 4)
> 5   and, the portal application provides the first view to the client (the portal application generate a
> 6   page (equivalent to applicant's first view) to the client, see, e.g., page 3, paragraph [0038] and step
> 7   416 in figure 4). The portal application runs the access checking logic and shows the result of the
> 8   access checking logic on the page to the client, wherein the page is equivalent to applicant's first
> 9   view. Therefore, the access checking logic is disposed in the page by showing the results of the
> 10   access checking logic process on the page.
> 11   The access checking logic is interpreted as a process checking which users are
> 12   authenticated to access backend applications. (emphasis added)

13

14   The Examiner's error in logic is exemplified by the Examiner's statement that "the access

15   checking logic is disposed in the page by showing the results of the access checking logic

16   process on the page." The Examiner's analysis is based upon the factually-unsupported assertion

17   that the results of the access checking logic corresponds to the access checking logic itself.

18

19   Since this alleged teaching is not explicitly found within Bazinet, Appellant can only

20   presume that the Examiner is relying upon the doctrine of inherency. However, such a reliance

21   upon the doctrine of inherency to disclose this feature is misplaced. Inherency may not be

22   established by probabilities or possibilities. The mere fact that a certain thing may result from a

23   given set of circumstances is not sufficient to establish inherency.[2] To establish inherency, the

24   extrinsic evidence must make clear that the missing element must necessarily be present in the

25   thing described in the reference, and that the necessity of the feature's presence would be so

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[2] In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

1   recognized by persons of ordinary skill.[3] Furthermore, reference is made to <u>ex parte Schricker</u>,[4]

2   in which the Honorable Board of Patent Appeals and Interferences stated the following:

> 3   However, when an examiner relies on inherency, it is incumbent on the examiner to point to the
> 4   "page and line" of the prior art which justifies an inherency theory. <u>Compare</u>, <u>In re Rijckaert</u>, 9
> 5   F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an
> 6   explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or
> 7   suggestion appears in the prior art); <u>In re Yates</u>, 663 F.2d 1054, 107, 211 USPQ 1149, 1151
> 8   (CCPA 1981).

9

10   The Examiner did not discharge the burden of indicating where such a teaching or suggestion

11   appears in the prior art. Thus, the Examiner has not established that this limitation is inherently

12   disclosed by Bazinet.

13

14   The Examiner's assertion reflects a fundamental misunderstanding between the

15   differences between logic and the results of the logic. For example, the logic of many websites

16   are found within the server (commonly known as "server side logic"[5]). In this scenario, the

17   process involving the logic is performed within the server, and the result of the process is

18   forward to the client for display. However, the fact that the "results of the .... logic process" is

19   being displayed on a particular page does not necessarily (i.e., inherently) mean that the logic

20   itself is disposed within the page. This is well-known concept associated with client-server

21   interactions that does not appear to be appreciated by the Examiner. Therefore, for the reasons

22   stated above, Appellant respectfully submit that the Examiner has erred by relying upon findings

23   of fact that are <u>not</u> based upon substantial evidence. Instead, the Examiner is making assertions

24   as to equivalency and/or inherency that are simply incorrect.

25

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[3] <u>Finnegan Corp. v. ITC</u>, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); <u>In re Robertson</u>, 169 F.3d 743, 745 49
USPQ2d 1949, 1950-51 (Fed. Cir. 1999); <u>Continental Can Co. USA v. Monsanto Co.</u>, 20 USPQ 2d 1746 (Fed. Cir.
1991); <u>Ex parte Levy</u>, 17 USPQ2d 1461 (BPAI 1990).
[4] 56 USPQ2d 1723, 1725 (BPAI 2000).
[5] For example, 73 U.S. Patents include the phrase "server side logic."

1   Upon reviewing the Bazinet, Appellant has been unable to find any mention that blocks

2   406-414 in Figure 4 (i.e., the logic being relied upon by the Examiner) is disposed within the

3   alleged first view of Bazinet. Thus, the Examiner has mischaracterized the scope and content of

4   Bazinet.

5

6   _____

7   On pages 13 and 14 of the Examiner's Answer, in response to Appellant's arguments as to

8   the Examiner's obviousness analysis, the Examiner asserted the following:

9   Examiner's response: Bazinet teaches the access control by authentication information
10   (the authentication information includes user name and password combination, data on a
11   smartcard etc, see, e.g., page 3, paragraph [0037]). Vasandani teaches the deficiency of role based
12   access control (a useriD-role database and a resource-role database for use in a web server to grant
13   access to web resources to users, see, e.g., col. 2, lines 58-62), though it is obvious to include the
14   user roles in the authentication information.
15   In this case, the obviousness can be established by modifying the authentication
16   information taught of Bazinet to produce the claimed invention in the knowledge generally
17   available to one or ordinary skill in the art.
18   By such modification, it provides various access levels based on the user role and
19   provides efficient access control for each different role as well known to one or ordinary skill in
20   the art.
21

22   The Examiner's response, however, is non-responsive to Appellant's arguments. For

23   example, the last of the above-reproduced paragraphs merely repeats what the Examiner asserted in

24   the Second Office Action. The Examiner also presents the contradictory statement that Vasandani

25   teaches the deficiency of role based access control while at the same time asserting that it would

26   have been obvious to include user roles for authentication. Finally, the second of the above-

27   reproduced paragraphs is a conclusory statement that does not accurately reflect the law with regard

28   to obviousness. For example, the Examiner is confusing findings of fact necessary to make a

29   determination of obviousness (i.e., "obviousness can be established by") with the proposed

30   modification (i.e., "by modifying the authentication information taught of Bazinet").

1

2   On October 10, 2007, the Patent Office issued the "Examination Guidelines for

3   Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR

4   International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination

5   Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103."

6   Within this section is the following quote from the Supreme Court: "rejections on obviousness

7   grounds cannot be sustained by merely conclusory statements; instead there must be some

8   articulated reasoning with some rational underpinning to support the legal conclusion of

9   obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn,

10   441 F.3d 977, 988 (Fed. Cir. 2006)).

11

12   Referring to the first column on page 57,529 of the Examination Guidelines for

13   Determining Obviousness, the following is a list of rationales that may be used to support a

14   finding of obviousness under 35 U.S.C. § 103:

15   (A) Combining prior art elements according to known methods to yield
16   predictable results;

17   (B) Simple substitution of one known element for another to obtain
18   predictable results;

19   (C) Use of known technique to improve similar devices (methods, or
20   products) in the same way;

21   (D) Applying a known technique to a known device (method, or product)
22   ready for improvement to yield predictable results;

23   (E) "Obvious to try" - choosing from a finite number of identified,
24   predictable solutions, with a reasonable expectation of success;

25   (F) Known work in one field of endeavor may prompt variations of it for
26   use in either the same field or a different one based on design incentives or other

1   market forces if the variations would have been predictable to one of ordinary

2   skill in the art;

3   (G) Some teaching, suggestion, or motivation in the prior art that would

4   have led one of ordinary skill to modify the prior art reference or to combine prior

5   art reference teachings to arrive at the claimed invention.

6

7 Upon reviewing the Examiner's analysis on page 5 of the Examiner's Answer and the Examiner's

8 further analysis on pages 13 and 14, the Examiner's analysis does not comport to any of these

9 rationales.

10

11   Therefore, for the reasons submitted above, Appellants respectfully submit that the

12 Examiner has failed to establish that the claimed invention would have been obvious in view of

13 the applied prior art.

14

15   <u>Rejection of claim 8 under 35 U.S.C. § 103</u>

16   On page 14 of the Examiner's Answer, in response to Appellant's separate arguments as

17 to claims 8 and 12, the Examiner asserted the following:

18   Examiner's response: Bazinet teaches that the portal application runs the access checking
19   logic and shows the result of the access checking logic on the page to the client, wherein the page
20   is equivalent to applicant's first view. Therefore, the first view (the page to the client) identifies a
21   method call to access checking logic by showing the result of the checking authentication process
22   on the page.
23
24 Yet again, the Examiner is relying upon the teaching of "showing the result ... on the page" to

25 establish that Bazinet teaches another of the claimed limitations (i.e., "processing said selected

26 view to identify a method call to access checking logic"). For the reasons already discussed

27 above, the Examiner's arguments are inherency arguments that are <u>entirely</u> <u>factually</u>

28 <u>unsupported</u>.

For the reasons set forth in the Appeal Brief of July 21, 2008, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: January 5, 2008   Respectfully submitted,

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